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Docket No. 5595.210-US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Lav et al.  
Serial No. : 09/870,392 Examiner: Williams, Catherine Serke  
Filed : May 30, 2001 Art Unit: 3763  
Title : A Medical Apparatus For Use By A Patient For Medical  
Self Treatment of Diabetes

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## RESPONSE TO OFFICE ACTION

TECHNOLOGY CENTER 3700

I hereby certify that this paper is being deposited with the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on April 13, 2004.

Robert B. Smith

Reg. No. 28,538

Signature

April 13, 2004

Date

April 13, 2004

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313

Sir:

In response to the Office Action dated March 17, 2004, the applicant hereby explains how the requirements of 35 U.S.C. § 135(b) are met with respect to the proposed interference.

Section 135(b) provides, in relevant part,

(1) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

M.P.E.P. § 2307 further provides:

Note that the expression "prior to one year from the date on which the patent was granted" in 35 U.S.C. 135(b) includes the one-year anniversary date of the issuance of a patent. *Switzer v. Sockman*, 333 F.2d 915, 142 USPQ 226 (CCPA 1964).

In this case, the applicants seek to provoke an interference with U.S. patent No. 6,192,891, which issued on February 27, 2001. Therefore, under 35 U.S.C. § 135(b), the statutory bar date for filing interfering claims was February 27, 2002.

Claims 11-31 were filed as part of a Supplemental Preliminary Amendment mailed on February 27, 2002. The Amendment bore on its face a certificate of mailing under 37 C.F.R. § 1.8 attesting to such mailing.

Rule 8 provides that:

(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed.

Among the various exceptions specified in paragraph (a)(2) are the filing of national applications and international applications, and entering the national stage of PCT applications. Thus, if a certain filing date is required to avoid

a statutory bar under Section 102(b), mailing a patent application to the PTO on the due date using a certificate of mailing would not be timely.

Rule 8 is unavailable, however, not because filing of an application or entry into the national stage falls outside of the stated scope of Rule 8, but because these acts are specific exceptions to Rule 8 procedures. In other words, if they were not listed in paragraph (a)(2), Rule 8 would apply to the filing of a patent application and entry into the national stage. The fact that filing of an application had to listed as an exception under paragraph (a)(2) means that filings similar to the filing of a patent application, but not listed in paragraph (a)(2), are withing Rule 8 and may employ Rule 8 procedures.

Here, the filing of claims 11-31 to meet a set date is similar to filing a patent application to meet a set date. Both are voluntary filings. In other words, the applicants were not required to file claims 11-31 - they did so in order to provoke an interference. In the case of a patent application, there is also no requirement that the applicant file such application - the applicant does so to obtain a patent. Both filings are also similar in that they are done so as to avoid a statutorily set bar date, i.e., Section 135 in the case of claims 11-31 versus Section 102(b) in the case of a patent application.

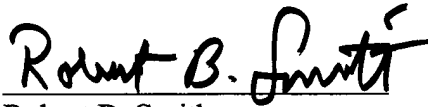
The difference between filing of a patent application and filing of the February 27, 2002 Amendment is that, while the former is expressly excluded from the protection of Rule 8 procedures, the filing of claims 11-31 is not. Thus, by

invoking the procedures of Rule 8, the February 27, 2002 Amendment is timely with respect to any statutory requirements to file claims by February 27, 2002.

Section 135 sets a period of time by which claims 11-31 needed to be filed. As recited above, Rule 8 specifies that a paper mailed with a certificate of mailing on the set date will be treated as being timely filed even if not received by the PTO until after such date. Here, the Supplemental Preliminary Amendment was mailed on the set date for filing interfering claims, February 27, 2002, and therefore even though it was received after such date, under Rule 8 it was timely filed. Thus, claims 11-31 were presented within one year of the issue date of the '891 patent.

The applicants respectfully request that an interference be declared based on claims 11-31.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert B. Smith", with a stylized flourish at the end.

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